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22879 7590 09/22/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD KENNEDY

Appeal 2008-1131
Application 10/080,999
Technology Center 2600

Decided: September 18, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 1, 2, 5-9, 32-36, 38, 40, and 41. At page 3 of the Answer, the Examiner has indicated the allowability of claim 41 subject to being written in independent form. Accordingly, only the Examiner's rejection of claims

1, 2, 5-9, 32-36, 38, and 40 is before us on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellant's invention relates to the remote transmitting of information from a portable electronic device for storage to a remotely coupled storage device through an intermediate electronic device. The provision of a communications link from a portable device to a remote device enables the portable device to offload data and thereby reduce reliance on the local memory of the portable device. (Spec. 2-4).

Claim 1 is illustrative of the invention and reads as follows:

1. A portable electronic device, comprising:
a CPU;
a transceiver coupled to said CPU, said transceiver capable of wireless communications;
a memory unit coupled to said CPU; and
an image capture device coupled to said CPU, said image capture device acquires an image;
wherein said transceiver wirelessly transmits said image to a remote storage device through an intermediate electronic device; and
wherein said transceiver automatically begins transmitting said images after said image is acquired by said image capture device.

The Examiner relies on the following prior art references to show unpatentability:

Fukuoka	US 6,300,976 B1	Oct. 9, 2001
Harris	US 6,738,643 B1	May 18, 2004 (filed Oct. 31, 2000)

Claims 1, 2, 5-9, 32-36, 38, and 40, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuoka in view of Harris.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUE

Under 35 U.S.C § 103(a), with respect to appealed claims 1, 2, 5-9, 32-36, 38, and 40, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Fukuoka and Harris to render the claimed invention unpatentable?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in

Graham v. John Deere Co., 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

Claims 1, 2, 8, 9, 32-36, and 38

Appellant’s arguments in response to the Examiner’s obviousness rejection of representative independent claim 1 based on the combination of Fukuoka and Harris assert a failure by the Examiner to establish a *prima facie* case of obviousness since all of the claimed limitations are not taught or suggested by the applied Fukuoka and Harris references.¹ Appellant initially attacks the Examiner’s reliance on Fukuoka with the contention that, in contrast to the claimed invention, Fukuoka does not disclose the wireless transmission of images from an image capture device to a remote storage device through an intermediate electronic device. According to Appellant

¹ Appellant argues claims 1, 2, 8, 9, 32-36, and 38 together as a group. *See* App. Br. 9-12. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

(App. Br. 9-11; Reply Br. 1-2), Fukuoka discloses only a hardwired connection between camera 30 and any downstream devices such as computer 32 and telephone 33.

Appellant further contends that the automatic dialing system disclosed by Harris does not remedy the deficiencies of Fukuoka. As asserted by Appellant (App. Br. 11; Reply Br. 2), Harris, while describing the wireless transmission of dialing information from a portable device, such as a PDA, to other devices, there is no indication that images are being transferred from the portable device to such other devices.

We do not find Appellant's arguments to be persuasive in convincing us of any error in the Examiner's stated position. As set forth by the Examiner (Ans. 5, 6, and 11), Fukuoka discloses the transfer of images from an image capture device (camera 30) through an intermediate device (wireless cellular phone 32) for wireless transmission to a remote storage device. In our view, a skilled artisan would have recognized and appreciated the obviousness of providing either a wired or a wireless connection between the camera 30 and the wireless intermediate device 32.

This viewpoint is in fact supported by the disclosure of Fukuoka. Contrary to Appellant's contention (Reply Br. 2) that "Fukuoka teaches only a hardwired connection between the camera 30 and any downstream device," we find precisely the opposite in Fukuoka. For example, the embodiment illustrated in Figure 5 of Fukuoka unambiguously discloses (col. 4, ll. 15-21) the transmission of images from camera 30 to downstream monitoring computer 33 through wireless communication.

With the above discussion in mind, it is our opinion that, to whatever extent the Examiner is relying on Harris to provide a suggestion of

wirelessly transmitting images from a camera to downstream devices, any such suggestive teaching is cumulative to what already exists in Fukuoka. Accordingly, although we find no error in the Examiner's proposed addition of Harris to Fukuoka, it is our opinion that the Examiner's obviousness rejection of representative independent claim 1, as well as claims 2, 8, 9, 32-36, and 38 not separately argued by Appellants, is sustainable based solely on the disclosure of Fukuoka.²

Claims 5-7 and 40

Although we found Appellant's arguments unpersuasive in convincing us of error in the Examiner's 35 U.S.C. § 103(a) rejection of claims 1, 2, 8, 9, 32-36, and 38, we reach the opposite conclusion with respect to the rejection of claims 5-7 and 40. Claims 5-7 and 40 are directed to the feature of initiation of the transmission of images by the portable electronic device's transceiver when the CPU in the portable electronic device determines that the memory coupled to the CPU has reached a threshold.

In addressing the language of claims 5-7 and 40, the Examiner has taken this position (Ans. 7 and 12) that, since Fukuoka discloses that the image capture device transmits status information such as whether the memory is full to the external processing device which controls the camera, such information would act as an obvious trigger to the image capture device

² The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

to begin transmitting images. We do not find any basis for this conclusion by the Examiner.

As pointed out by Appellant (App. Br. 12-13; Reply Br. 2-3), the camera 30 of Fukuoka is remotely controlled by an external processing device which governs the transmission of images by the camera. The fact that the CPU of the camera knows that the CPU memory is full does not necessarily mean that the transmission of images will begin as presently claimed since any command to transmit images comes from the external peripheral device. We further find nothing in the disclosure of Harris which remedies this deficiency of Fukuoka.

In view of the above discussion, since all of the claim limitations are not taught or suggested by the applied Fukuoka and Harris references, taken individually or collectively, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 5-7 and 40.

CONCLUSION

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1, 2, 5-9, 32-36, 38, and 40, we have sustained the rejection of claims 1, 2, 8, 9, 32-36, and 38, but have not sustained the rejection of claims 5-7 and 40. Accordingly, the Examiner's decision rejecting appealed claims 1, 2, 5-9, 32-36, 38, and 40 is affirmed-in-part.

Appeal 2008-1131
Application 10/080,999

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED-IN-PART

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